

Remarks/Arguments:

Applicant submits this Preliminary Amendment in association with a Request for Continued Examination (RCE) on said application. Applicant respectfully requests that the claim amendments made herein be entered in accordance with the filing of the RCE.

Claims 6-14 and 16-19 were pending in this application. Claim 12 has been canceled. Thus, claims 6-11, 13-14 and 16-19 are currently under consideration.

Claims 6 and 16 have been amended. The amendments to the claims are supported by the specification as filed. Specifically, each amended claim was amended to recite "a concave region extending into the board from the lower surface toward the upper surface whereby the apex of the concave region is disposed between the lower surface and the upper surface." Support for this amendment resides in the specification at, for example, page 8, lines 9-15, page 9, lines 2-4 and the figures, specifically FIGS. 1B and 2B. Applicants have further amended claims 6 and 16 as suggested by the Examiner to recite that the device comprises "only one" balancing insert. Support can be found throughout the specification.

I. DRAWINGS

The drawings were objected to for failing to include the "textured coating" of the concave region and the insert of claim 12. Applicant has cancelled claim 12 thus rendering this objection moot.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 6-14 and 16-19 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the action argues that the phrase "wherein the upper surface is adapted to permit the user to distribute the user's weight to any position on the upper surface" was not described in the specification. Applicant has removed this language from the claims, thus rendering this rejection moot.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 6-14 and 16-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Applicant has removed the noted language from the claims, thus rendering this rejection moot.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(B)

A. Arner et al.

Claims 6, 7, 9 and 16 are rejected under 35 U.S.C. § 102(b) as anticipated by Arner Jr. (USPN 4,191,371). Applicant respectfully traverses.

Claims 6 and 16 have been amended to clarify that the concave region extends "from the lower surface toward the upper surface whereby the apex of the concave region is disposed between the lower surface and the upper surface." No such limitation is presented by Arner et al. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Because the newly added limitation is not described Arner et al., this reference does not anticipate the claims as presently written.

B. Englund

Claims 6 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Englund (USPN 3,862,768). Applicant respectfully traverses.

Claim 12 has been cancelled. Claim 6 has been amended to clarify that the concave region extends "from the lower surface toward the upper surface whereby the apex of the concave region is disposed between the lower surface and the upper surface.", and no such limitation is presented by Englund. Based upon the precedent cited above, Englund does not anticipate claim 6.

C. Hall Jr.

Claims 6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall Jr. (USPN 5,415,589). Applicant respectfully traverses.

Hall, Jr. is directed towards a motion device specifically designed for use in amusement rides. Claim 6, from which claim 13 depends, specifically recites that the device comprises a

board and "only one" substantially spherical balancing insert. Hall, Jr. discloses a device in which multiple bearings separate two interacting components. The Office Action infers that the bearings, as inherently spherical, anticipate the spherical insert element of claim 6.

Claim 6 recites a device with only one spherical insert. Hall, Jr. does not disclose or suggest a device comprising only one spherical insert. The device disclosed by Hall, Jr. requires multiple bearings to separate the teetering member and the base, and therefore does not disclose or suggest the invention as claimed. Accordingly, withdrawal of the rejection is respectfully requested.

V. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

A. Armer, Jr. in view of Sasser, Jr.

Claims 8 and 10 are rejected under 35 USC 103(a) as being unpatentable over Armer, Jr. in view of Sasser, Jr. (USPN 3,488,049). Applicant respectfully traverses. Specifically, Applicant notes that these claims depend directly from independent claim 6, and, as such, Applicant directs the Examiner to arguments supporting the patentability of claim 6.

Further, Sasser, Jr. teaches away from adding a spherical insert, because a spherical insert would inherently increase the degrees of motion. Sasser, Jr. emphasizes that its roller configuration is an improvement over prior devices, such as the "Bongo Board" (see Sasser, Jr., col. 1, line 39-45) because it restricts motion and eliminates motion that is too challenging for novice users. Specifically noted are the limits of motion assured with the configuration as disclosed by Sasser, Jr.

Because Sasser, Jr. teaches away from increased motion in a balancing device, a person of ordinary skill would not have combined the Sasser, Jr. board with a spherical insert.

B. Coplin et al. in view of Armer Jr.

Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coplin et al. (USPN 3,024,021) in view of Armer, Jr. The action states that it would have been obvious to a person of ordinary skill in the art to enlarge Coplin's concave region to provide a user with a more challenging balance exercise device. Applicant respectfully traverses.

Coplin et al. provides a plate with a slight indentation that receives only a fraction of the top portion of the ball, and directs that the ball be secured to the indentation by a suitable adhesive so that the device will remain assembled when the device is moved from place to place (see col. 2, lines 12-16) and allow the user to skid the ball along the floor (see col. 2, lines 30-33). Such adhesion of the ball to the board, while deemed necessary by Coplin et al. completely teaches away from the claims of the present invention, and Armer Jr., where movement of the insert within the indentation is desired. The purpose of the larger cavity is to allow for movement of the insert throughout the cavity.

As originally set forth by the Supreme Court in *Graham v. John Deere*, and as recently confirmed by the Supreme Court in *KSR v. Teleflex*, the subject matter of the claimed invention "as a whole" must be considered in determining whether the claimed invention is obvious. *Graham v. John Deere Co. of Kansas*, 383 US 1 (1966); *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In accordance therewith, the MPEP provides that when applying 35 U.S.C. §103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. See MPEP § 2141 (II) citing *Hodosh v. Block Drug Co., Inc.* 786 F2d 1136, 1143 (Fed. Cir. 1986).

The present invention as claimed, when viewed as a whole, includes a concave region that encompasses an area greater than an area defined by the circumference of the balancing insert to allow for movement of the insert within the concave region. Coplin et al. when viewed as a whole, clearly teaches secure relationship between the insert and the concave region, wherein the insert is preferably adhered to the region. As such, Coplin et al. do not present a desirability to incorporate a concave region that encompasses an area greater than the area defined by the circumference of the balancing insert as required by the present claims. Therefore, Applicant respectfully requests that the rejection of claims 6 and 11 under 35 U.S.C. 103(a) as unpatentable over Coplin et al. in view of Armer, Jr. be withdrawn.

C. Englund in view of Sasser, Jr.

Claims 14 and 17-19 are rejected under 35 USC 103(a) as being unpatentable over Englund in view of Sasser, Jr. Applicant respectfully traverses. Specifically, Applicant notes that these claims depend directly or eventually from independent claims 6 and 16, and, as such, Applicant directs the Examiner to arguments supporting the patentability of such claims.

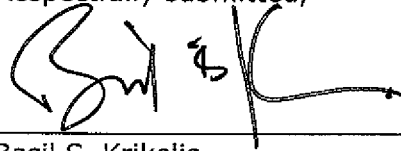
V. CONCLUSION

The foregoing is believed to be fully responsive to the May 1, 2007 office action. The embodiments presented are believed to be allowable over the prior art of record. Consideration and allowance of the claims is respectfully requested.

In the event that any fee has been inadvertently overlooked and is required, the Commissioner is hereby authorized to charge any required fee or credit any overpayment to **Deposit Account No. 50-3570.**

If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned. If the Examiner has any questions in connection with this paper, or otherwise if it would facilitate the examination of this application, please call the undersigned at the telephone number below.

Respectfully submitted,



Basil S. Krikelis
Registration No. 41,129
Attorney for Applicant

Dated: October 9, 2007

McCarter & English, LLP
Renaissance Centre
405 N. King Street, 8th Floor
Wilmington, DE 19801
Phone: (302) 984-6393
Fax: (302) 984-6399